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Paper No.

STEINS & ASSOCIATES
2333 CAMINO DEL RIO SOUTH
SUITE 120
SAN DIEGO CA 92108

MAILED

APR 20 2011

OFFICE OF PETITIONS

Patent No. 6,149,165 :
Tuan Nguyen :
Issue Date: November 21, 2000:
Application No. 09/104,852 : DECISION ON PETITION
Filed: June 25, 1998 :
Attorney Docket No. NGU1-A94A :

This is in response to the PETITION FOR REINSTATEMENT OF PATENT EXPIRED UNINTENTIONALLY UNDER 37 CFR 1.378(b) filed June 17, 2010, which given statements and surcharge paid on petition is properly treated under the unintentional standard of 37 CFR 1.378(c).

The petition is **DISMISSED**.

BACKGROUND

The patent issued November 21, 2000. The window for paying the first maintenance fee extended from November 21, 2003 through May 21, 2004 without surcharge, and from May 22, 2004 through November 21, 2004 with surcharge. A Notice of Patent Expiration was mailed on December 22, 2004.

In response to the Notice of Patent Expiration, an initial petition was filed on May 25, 2005. Therein, patentee argued that the maintenance fee and late surcharge were timely filed on May 27, 2004. In support thereof, patentee submitted copies of their certificate of facsimile transmission and their facsimile activity report. However, patentee did not submit a complete copy of the 5 page maintenance fee payment as they maintain it was originally filed on May 27, 2004. Accordingly, by decision mailed June 30, 2005, the petition was dismissed. The decision requested a copy of the complete facsimile transmission.

Patentee did not respond to the decision. No further action was taken by patentee within 24 months of the expiration date of the patent. On January 9, 2006, the Office refunded the maintenance fee and surcharge (as is practice when a patent is not reinstated).

The window for paying the second maintenance fee (if this patent were not expired) would have extended from November 21, 2007 through May 21, 2008 without surcharge, and from May 22, 2008 through November 21, 2008 with surcharge.

OPINION

On instant petition, Patentee maintains that the decision of June 30, 2005 was not received. Patentee does not submit evidence to meet the Delgar¹ standard for establishing non-receipt of an Office action. Further, Patentee does not explain their actions as to inquiring regarding the status of the petition.

¹ The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.

Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.

Moreover, the instant petition was not filed within twenty-four months after the actual expiration of the six-month grace period at midnight on January 22, 2004. Absent a showing that the first maintenance fee was timely paid, the instant petition cannot be granted under 37 CFR 1.378(c).

In other words, petitioner must answer the questions raised by the decision originally mailed on June 30, 2005 (A courtesy copy of that decision is enclosed). Further, petitioner must establish non-receipt of the decision and show to the satisfaction of the Office that the entire delay should be considered unintentional (or unavoidable, as discussed below).

Furthermore, the petition does not include adequate fees. Although the petition references submitting \$5,010 in fees, Office records only show receipt of a \$2,130 credit card payment. The 3.5 year maintenance fee for a small entity is \$490. The 7.5 year maintenance fee is \$1,240. The unintentional delay surcharge is \$1,640. The petition fee for renewed consideration under 37 CFR 1.378(e) is \$400. As discussed above, the fees submitted with the first petition were refunded in January of 2006. As such, those fees need to be resubmitted. In addition, as this is a renewed petition, the \$400 fee under 37 CFR 1.378(e) is required. Sufficient fees need to be submitted on renewed petition to cover the deficiency in payment of the first and second maintenance fees, unintentional delay surcharge and petition fee.

If the first maintenance fee is shown to have been timely paid, and the delay in filing this renewed petition is excused, then it can be considered whether the failure to pay the second maintenance fee was unintentional within the meaning of 37 CFR 1.378(c) as this petition filed June 17, 2010 was filed within 24 months of the expiration of the period for paying the second maintenance fee, which ended November 21, 2008.

On the other hand, if the first maintenance fee is not shown to have been timely paid, patentee may only obtain reinstatement of this patent via the provisions of 37 CFR 1.378(b). Under such provisions, patentee must show that the entire delay in paying the maintenance fees was unavoidable.

CONCLUSION

For the reasons set forth above, it is concluded that petitioner has not met his burden of showing that the delay in paying the maintenance fee was unintentional within the meaning of 37 CFR 1.378(c).

In view thereof, the petition is dismissed.

Any request for reconsideration of this decision must be filed within **TWO MONTHS** of the mailing date of this decision. This period is not extendable under the provisions of 37 CFR 1.136(a). Any such petition for reconsideration must be accompanied by the \$400 petition fee set forth in § 1.17(h). After decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director. Accordingly, on request for reconsideration, it is extremely important the petitioner supply any and all relevant information and documentation in order to meet his burden of showing unintentional delay.

If on request for reconsideration, the delayed payment of the maintenance fee is not accepted, then the maintenance fee and the surcharge set forth in §1.20(i) are subject to refund following the decision on the petition for reconsideration, or after the expiration of the time for filing such a petition for reconsideration, if none is filed. (Petitioner may request a refund of the maintenance fee and surcharge by writing to the Office of Finance, Refund Section, Commissioner for Patents, Washington DC 20231. A copy of the last decision rendered should accompany the request for refund).

Alternatively, patentee may file a petition under 37 CFR 1.378(b). The filing of such a petition should not be intentionally delayed, as the entire delay will be considered in determining whether patentee has shown that the delay in paying the maintenance fee was unavoidable within the meaning of 37 CFR 1.378(b).

Further correspondence with respect to this decision should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By fax: (571) 273-8300
ATTN: Office of Petitions

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3219.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

cc: Courtesy Copy of decision mailed June 30, 2005.



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Paper No. 10

STEINS & ASSOCIATES
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SAN DIEGO, CA 92108

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JUN 30 2005

OFFICE OF PETITIONS

In re Patent No. 6,149,165	:
Tuan Nguyen	:
Issue Date: November 21, 2000	: ON PETITION
Application No. 09/104,852	:
Filed: June 25, 1998	:
Attorney Docket No. NGU1-A94A	:

This is in response to the Petition to Accept Maintenance Fee pursuant to 1.378(b) filed May 25, 2005, which is properly treated as a petition under 37 CFR 1.377 to accept and record a maintenance fee.

The petition under § 1.377 is **DISMISSED**.

Patentee is given **TWO (2) MONTHS** from the mail date of this decision to respond. This period is not extendable. See § 1.181(f).

The above-identified patent issued on November 21, 2000. The window for paying the first maintenance fee extended from November 21, 2003 through May 21, 2004 without surcharge, and from May 22, 2004 through November 21, 2004 with surcharge. A Notice of Patent Expiration was mailed on December 22, 2004.

Patentee asserts that the maintenance fee (with surcharge) was timely filed by facsimile transmission on May 27, 2004. In

support thereof, petitioner states that they are submitting a copy of the 5 page facsimile communication as presented to the Office on May 27, 2004.

37 CFR § 1.377 provides that:

- (a) Any patentee who is dissatisfied with the refusal of the Patent and Trademark Office to accept and record a maintenance fee which was filed prior to the expiration of the patent may petition the Director to accept and record the maintenance fee.
- (b) Any petition under this section must be filed within 2 months of the action complained of, or within such other time as may be set in the action complained of, and must be accompanied by the fee set forth in § 1.17(h). The petition may include a request that the petition fee be refunded if the refusal to accept and record the maintenance fee is determined to result from an error by the Patent and Trademark Office.
- (c) Any petition filed under this section must comply with the requirements of § 1.181(b) and must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest.

To show late receipt of the Notice of Patent Expiration, petitioner submits a copy of the envelope they state the Notice was received in. The envelope bears a postmark date of February 25, 2005. Considering this evidence, it is concluded that the petition was promptly filed after becoming aware of the expiration of the patent.

However, petitioner's evidence does not show that the maintenance fee and surcharge were filed prior to the expiration of the patent. First, of all, only 3 pages of the 5 pages of the copy of the facsimile said to have originally been submitted were received on petition. Those pages were limited to a certificate of transmission dated May 27, 2004 and a facsimile confirmation sheet supporting a conclusion that 5 pages were received in the Office on May 27, 2004. The certificate was on a separate page and certified that correspondence entitled "Maintenance Fee Payment" was being faxed. Yet, a copy of the correspondence entitled "Maintenance Fee Payment" was not provided on petition. Moreover, petitioner alleges that the payment of the required fee in the above-identified patent was

directed to be paid by a Credit Card. The evidence does not show that as of May 27, 2004, any payment of the maintenance fee and surcharge would have been honored had it been presented to the Credit Card company.

On renewed petition, patentee must make a showing that the paper as filed by facsimile on May 27, 2004 included an authorization to charge a Credit Card the required fees, and that the authorized Credit Card account had sufficient funds available to make such a payment.

(The maintenance fee having never been charged is now being charged to petitioner's Credit Card, pursuant to the Credit Card authorization submitted on petition. If the payment is ultimately not accepted, the payment will be refunded.)

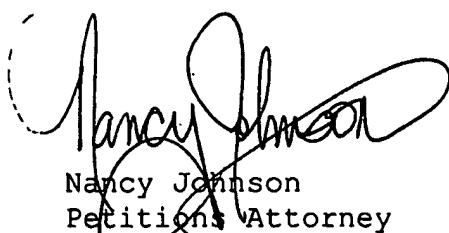
Further correspondence with respect to this decision should be addressed as follows:

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Commissioner for Patents
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Alexandria, VA 22313-1450

By fax: (703) 872-9306
ATTN: Office of Petitions

By hand: Customer Service Window
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Telephone inquiries specific to this decision may be directed to the undersigned at (571) 272-3219.



Nancy Johnson
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